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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,963	02/01/2002	Martin Steinwender	20496-321	8756

21890 7590 10/21/2004

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PATENT DEPARTMENT
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EXAMINER

SAFAVI, MICHAEL

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/061,963

Applicant(s)

STEINWENDER, MARTIN

Examiner

M. Safavi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-20 and 23-37 is/are pending in the application.
- 4a) Of the above claim(s) 25-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-20, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 28, 2004 has been entered.

Claim 24 is objected to because of the following informalities: Line 3 of claim 24 should read --said at least one joint face--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-10, 12-17, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Marinelli. Marinelli discloses, Figs. 1-3, a joint between two components utilizing a multi-component adhesive which adhesive can take the form of a layer of matrix 29/30 containing micro capsules 28. Layers of the matrix 29/30, (such as upper most layer and lower most layer), do not possess microspheres with the microspheres lying in the central portion of the matrix, col. 4, lines 1-17. The matrix contains at least one element of the reaction adhesive system with the capsules containing at least a second element of the reaction adhesive system.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 12-17, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roesch et al. in view of Marinelli.

4. Roesch et al. discloses, Figs. 1-3, a joint between two components utilizing a multi-component adhesive which adhesive can take the form of a matrix 5 and micro capsules 1, Fig. 1, as well as layers of matrix 5 and micro capsules 1, Fig. 2, as well as application of two different types of micro capsules possessing different materials of the reaction adhesive system. The capsules are distributed as a layer along an upper surface or upper portion of the matrix as

defined by Roesch et al. at lines 18-24 and 60-65 of col. 9 which teaches applying the adhesive in the form of a matrix having the micro capsules distributed along a layer thereof.

Arguments to Marinelli may be found above. To have enhanced the Roesch et al. adhesive system as by applying a second or upper layer of matrix upon or over the micro capsules, thus serving to assure a more secure holding of the micro capsules to the surface, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by Marinelli at col. 4, lines 1-17.

5. Claims 1-10, 12-20, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Nemeth or German reference 297,03,963 in view of Roesch et al and further in view of Marinelli.

Nemeth discloses, Fig. 9, utilization of adhesive within a joint between two components of a floor covering. German reference '963 discloses, Figs. 1 and 2, utilization of adhesive within a joint between two components of a floor covering.

Arguments to Roesch et al. and Marinelli, (and particularly Roesch et al. in view of Marinelli) can be found above.

To have applied any of the multi-component adhesive systems disclosed in Roesch et al. within the floor covering connections of either of Nemeth or German reference '963 while enhancing the Roesch et al. adhesive system as by applying a second or upper layer of matrix upon or over the micro capsules, thus taking advantage of any of various well known multi-component adhesives while serving to assure a more secure holding of the micro capsules to the surface, would have been obvious to one

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having ordinary skill in the art at the time the invention was made as taught by Roesch et al. while further considering Marinelli.

6. Claims 1-10, 12-20, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Nemeth or German reference 297,03,963 in view of Marinelli.

Nemeth discloses, Fig. 9, utilization of adhesive within a joint between two components of a floor covering. German reference '963 discloses, Figs. 1 and 2, utilization of adhesive within a joint between two components of a floor covering.

Marinelli discloses, Figs. 1-3, a joint between two components utilizing a multi-component adhesive which adhesive can take the form of a layer of matrix 29/30 containing micro capsules 28. Layers of the matrix 29/30, (such as upper most layer and lower most layer do not possess microspheres with the microspheres lying in the central portion of the matrix. The matrix contains at least one element of the reaction adhesive system with the capsules containing at least a second element of the reaction adhesive system.

To have applied any of the multi-component adhesive systems disclosed in Marinelli within the floor covering connections of either of Nemeth or German reference '963, thus taking advantage of any of various well known multi-component adhesives, would have constituted an obvious expedient to one having ordinary skill in the art at the time the invention was made.

7. Claims 10, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marinelli in view of Hilbelink et al.

Marinelli discloses, Figs. 1-3, a joint between two components utilizing a multi-component adhesive which adhesive can take the form of a layer of matrix 29/30 containing micro capsules 28. Layers of the matrix 29/30, (such as upper most layer and lower most layer), do not possess microspheres with the microspheres lying in the central portion of the matrix, col. 4, lines 1-17. The matrix contains at least one element of the reaction adhesive system with the capsules containing at least a second element of the reaction adhesive system.

Hilbelink et al. discloses utilization of various adhesive systems including two component adhesive systems having one and a second component encapsulated as well as one component encapsulated and a second component within a matrix within which the encapsulated component is contained.

To have provided the adhesive system of Marinelli with matrix 29/30 containing capsules possessing one component of the reaction adhesive as well as capsules possessing a second component of the reaction adhesive, thus allowing a uniform dispersion of the components of the Marinelli adhesive system, would have constituted an obvious expedient to one having ordinary skill in the art at the time the invention was made, as taught by Hilbelink et al.

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Response to Arguments

8. Applicant's arguments filed June 28, 2004 have been fully considered but they are not persuasive. Marinelli does disclose a system having a matrix with "multiple capsules dispersed completely within" as is described at lines 1-17 in col. 4 of Marinelli.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2168.



**MICHAEL SAFAVI
PRIMARY EXAMINER
ART UNIT 354**

M. Safavi
October 14, 2004